

The claims have been amended to define the fiber cavities as being open or semi-open cavities. Support is found in the specification as originally filed on page 2, lines 17-23 and page 9, lines 12-13, for example. Also, the preamble of claims 3-5 has been amended to be consistent with claims 1 and 2. All of the amendments were made solely for the purpose of clarification and not in response to any prior art rejection. Finally, claims 7-9 have been added and these claims define a cigarette comprising a tobacco rod and a filter. Support is found throughout the specification, and such cigarettes are illustrated in Figures 1, 2 and 5 of the drawing.

Applicant respectfully submits that claims 1-9 define a cigarette filter and a cigarette including a filter which are neither shown nor suggested by the prior art taken alone or in combination with one another. Specifically, claims 1-9 are not rendered obvious by the combination of Rohrbach et al US 5,744,236 ("Rohrbach"), Woods et al US 4,729,391 ("Woods) and Keritsis US 5,133,367, for the reasons expressed below.

Fundamentally, the present invention relates to a unique cigarette filter comprising a micro porous fiber with open or semi-open cavities therein. The cavities are loaded with a flavorant delivering material in solid or liquid form. The fiber may be a trilobal fiber or a quadrilobal fiber, and the flavorant may be pure methanol in solid powder form or in dissolved or melt liquid forms. Also, the methanol flavorant may be supported on an adsorption/absorption particle. As tobacco smoke is drawn through the cigarette filter flavorant is released into the smoke stream.

Rohrbach is the primary reference utilized in the rejection of the claims. Applicant is well aware of Rohrbach and it is identified and discussed in the present specification on page 5, lines 12-17. However, the significant difference between the present invention as

claimed and Rohrbach is Rohrbach's failure to disclose or suggest that the fibers can be used in cigarette filters. Instead the fibers of Rohrbach are used for the removal of odors not the release of flavor, a purpose which is the very antithesis of adsorption. Rohrbach is directed to a fundamentally different purpose because odors are absorbed while in the present invention flavor is released.

This deficiency of Rohrbach is recognized by the Examiner who then resorts to combining Rohrbach with Woods which discloses particular cigarette filter constructions. However, applicant respectfully submits that this combination is improper because there is no suggestion, teaching or motivation to combine the prior art in this manner.

35 USC §103 requires that the claimed subject matter as a whole not be obvious to a person of ordinary skill in the art at the time the invention was made. This phrase guards against entering into the tempting, but forbidden zone of hindsight. Applicant respectfully submits that the Examiner is resorting to prohibited hindsight in the rejection of the claims while utilizing the present disclosure as a blueprint for the formulated rejection. The Examiner may properly reject the claims in this application by showing a suggestion, teaching or motivation to combine the prior art. However, no such suggestion, teaching or motivation exists in the prior art combination of Rohrbach and Woods relied upon in the rejection. Instead the Examiner correctly concludes that Rohrbach does not teach or suggest cigarette filters, but then improperly concludes that since cigarette filters are old as shown by Woods it would be obvious to utilize the fibers of Rohrbach in the cigarette filter of Woods. But where is the suggestion, teaching or motivation to make this combination? Absent the present disclosure there is no such suggestion, teaching or motivation.

Rohrbach actually teaches away from the present invention because the odor problem addressed by Rohrbach is allegedly resolved by absorbing the odors into an adsorbent held in the fibers. In direct contrast to this fundamental principle of Rohrbach, in the present invention a flavorant loaded into microporous fibers is released during the smoking process.

Applicant respectfully submits that the Examiner must provide full reasoning as to what motivation or teaching in the prior art would suggest combining the references relied upon in the obviousness rejection. It is well established that the Examiner's general common knowledge and common sense do not substitute for the authority required by law to reject a claim for obviousness. In re Sang-Su Lee, 61 USPQ 2d 1430 (CAFC 2002).

The Examiner must consider the references as a whole, In re Yates, 211 USPQ 1149 (CCPA 1981). The Examiner cannot selectively pick and choose from the disclosed multitude of parameters without any direction as to the particular one selection of the references without proper motivation. The mere fact that the prior art may be modified to reflect features of the claimed invention does not make the modification, and hence the claimed invention, obvious unless the desirability of such modification is suggested by the prior art. In re Baird, 29 USPQ 2d 1550 (CAFC 1994) and In re Fritch, 23 USPQ 2d 1780 (Fed. Cir. 1992). Applicant disagrees with the Examiner why one skilled in the art with the knowledge of the references would selectively modify the references in order to arrive at the applicant's claimed invention. The Examiner's argument is clearly based on hindsight reconstruction.

In summary, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion, or incentive

supporting this combination. In re Geiger, 2 USPQ 2d 1276 (Fed. Cir. 1987). Applicant respectfully submits that there is no reason for one skilled in the art to combine Rohrbach and Woods and such rejection should be withdrawn.

Keritsis is simply relied upon for its disclosure of particular flavorants. Keritsis does not address the above described deficiency of the Rohrbach/Woods combination, and accordingly all of the claims distinguish over the prior art combination relied upon by the Examiner.

Accordingly, in the absence of additional prior art of increase pertinency, it is abundantly clear that claims 1-9 define an invention unsuggested by the prior art relied upon in the rejection. A formal Notice of Allowance is believed to be order and respectfully requested.

Respectfully submitted,

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Enclosure: Appendix I

Appendix I
Serial No.: 09/839,760

1. A cigarette filter comprising a micro-porous fiber with open or semi-open cavities which are loaded with a flavorant delivering material in solid or liquid forms.
2. A cigarette filter as in claim 1 wherein the fiber is a trilobal fiber with continuous open or semi-open cavities.
3. [Cigarette filters] A cigarette filter as in claim 1 wherein the fiber is a quadrilobal fiber with continuous open or semi-open cavities.
4. [Cigarette filters] A cigarette filter as in claim 2 wherein the fiber is loaded with pure methanol flavorant delivering material in solid powder form or in dissolved or melt liquid forms .
5. [Cigarette filters] A cigarette filter as in claim 2 wherein the fiber is loaded with methanol flavorant delivering material supported on an adsorption/absorption particle.